

REMARKS

Applicant has carefully reviewed the Office Action of November 26, 2003 and offers the following remarks in response thereto.

Claims 1, 4-7, 12, 13, 16-19, 36, 38-40, 52, 54, 55, 59, 60, and 62-69 were rejected under 35 U.S.C. § 103 as being unpatentable over Johnson et al. (hereinafter "Johnson") in view of Cremia. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where in the references each and every claim element is taught. MPEP § 2143.03. When the Patent Office is selecting references to combine, the references must be analogous. The test for analogousness is: "to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." The section goes on to state that "a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the subject matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." MPEP § 2141.01(a), internal citations omitted. Still further, the Patent Office must present objective evidence as to the motivation to combine references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Such objective evidence is required for to combine the references, but if the references must be modified from the combination to arrive at the claimed invention, the Patent Office is required to present further objective evidence demonstrating the suggestion to modify the combination. *Id.*

With respect to claim 1, the Patent Office opines that Johnson shows "the audio segments comprising at least portions of the network-related announcements to be played to a recipient," but then admits that Johnson does not show "playing the sequence of audio segments to the recipient so that the recipient is apprised of at least one network-related announcement." Applicant has studied the reference and finds no teaching or suggestion that the audio segments of Johnson are related to network-related announcements. Johnson's audio segments are part of a voice mail system that allows employees to create automated voice mail messages to prompt callers to leave messages or provide alternate routes of communication with the user (see col. 1, lines 15-25). These messages are not network-related announcements.

The Patent Office relies on Cremia to supply the missing element. Applicant respectfully traverses this on multiple levels. Initially, Cremia is non-analogous art. Cremia is designed to

support media playback to a user with targeted advertising (see col. 1, lines 8-11 and col. 2, lines 11-19). This is not within Applicant's field of endeavor. Since the reference is not within Applicant's field of endeavor, the reference fails the first prong of the test for analogousness. Further, the reference is not reasonably pertinent because the subject matter with which it deals, logically would not have commended itself to an inventor's attention in considering his problem. Specifically, when faced with the problem of trying to provide audio segments to the recipient so that the recipient is apprised of a network-related announcement, one does not look to a reference that elicits demographic information from a person requesting multimedia content and sending targeted advertising to the person. Thus, the reference fails the second prong of the test for analogousness. Since the reference fails both prongs of the test for analogousness, the reference is not analogous and cannot be used to support the rejection. Since the reference cannot be used to support the rejection and Johnson by itself admittedly does not teach or suggest all the claim elements, the Patent Office has not established *prima facie* obviousness and the claims are allowable.

Assuming, *arguendo*, that Cremia is analogous, the Patent Office still has not satisfied its burden in establishing *prima facie* obviousness. Specifically, the Patent Office is required to present objective evidence as to why two references should be combined. The Patent Office provides no such objective evidence, merely stating "it would have been obvious . . . to combine the teaching of Johnson and Cremia because Cremia's teaching of network-related announcement would allow the system to broadcast information to large audiences." This statement is not supported with a citation as to the source or rationale behind the motivation to combine the references.

Applicant further traverses the motivation on the grounds that the motivation ignores the realities of the network-related announcements. One of the primary concerns in telephone networks is overburdening the network with unnecessary messages. Thus, one of the goals of network management is to reduce overhead. Support for this can be found in the incorporated patent application entitled "Methods and Systems for Building and Distributing Audio Packages" (see page 21, lines 19-21). Thus, to broadcast information to large audiences undercuts one of the goals propounded by the present application. Thus, no one faced with the problem solved by Applicant would use the motivation advanced by the Patent Office. Since the motivation is improper, the references cannot be combined, and the references individually do not teach or

suggest all the claim elements. Since the references individually do not teach or suggest all the claim elements, the Patent Office has not established *prima facie* obviousness.

Applicant still further traverses the motivation and the resulting combination as failing to establish *prima facie* obviousness. Specifically, Cremia does not teach network-related announcements. The Patent Office opines that Cremia teaches network-related announcements on col. 3, line 61-col. 4, line 16. However, a reading of this passage shows that the passage deals with public service announcements like attending school (col. 4, line 1). The passage also indicates that news updates may be provided based on zip code or other demographic information (col. 4, lines 12-15). However, this sort of public service announcement and news is not the same thing as a network-related announcement as recited in the claim. Since Cremia does not teach network-related announcements, the motivation advanced by the Patent Office that network-related announcements would reach a large audience is not satisfied by the combination of the references. Furthermore, since Cremia does not show the claim element and Johnson admittedly does not have the claim element, even the combination of references does not show the claim element, and the Patent Office has not established *prima facie* obviousness.

Claims 4-6 depend from claim 1 and are patentable at least for the same reasons.

Claims 7, 12, 36, 40, 52, 55, 59, 60, 63, and 67 likewise recite the network-related announcement, and thus are patentable for reasons explained above with respect to claim 1.

Claims 13 and 16-19 depend from claim 12 and are patentable at least for the same reasons.

Claim 38 and 39 depend from claim 36 and are patentable at least for the same reasons.

Claim 54 depends from claim 52 and is patentable at least for the same reasons.

Claim 62 depends from claim 60 and is patentable at least for the same reasons.

Claims 64-66 depend from claim 63 and are patentable at least for the same reasons.

Claims 68 and 69 depend from claim 67 and are patentable at least for the same reasons.

In light of the deficiencies of in the combination of the references, Applicant requests withdrawal of the § 103 rejection of claims 1, 4-7, 12, 13, 16-19, 36, 38-40, 52, 54, 55, 59, 60, and 62-69 at this time.

Claims 2, 3, 10, 11, 37, 53, 56, and 61 were rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Cremia and further in view of Schuster et al. (hereinafter "Schuster"). Applicant respectfully traverses. The standards for obviousness are set forth above.

This rejection relies on the underlying combination of Johnson and Cremia. As explained above, this combination is improper for multiple reasons and remains improper in this rejection. Nothing in Schuster cures the problems of the combination of Johnson and Cremia. To this extent, the claims are allowable over the rejection of record.

Applicant further traverses several specific aspects of this combination. Applicant initially traverses the motivation to combine the references. In its analysis of claim 2, the Patent Office opines that it would be obvious to combine the references because Schuster's teaching of MGCP would provide a high fidelity voice/audio transmission that overcomes the sound quality limitations associated with the existing PSTN communication system, pointing to Schuster, col. 3, lines 60-63. While Schuster may be directed to a high fidelity voice/audio transmission, the high fidelity is not provided by the use of MGCP, and thus the basis for the combination is improper. Schuster provides his high fidelity through the use of a line card that uses high fidelity sampling and compression techniques (see Schuster, col. 3, line 66-col. 4, line 5). As such, the high fidelity is provided independently of the protocol used. In fact, the reference indicates that SIP is preferred over MGCP (see col. 6, lines 40-42). Thus, a desire to provide high fidelity voice/audio transmission does not compel the use of MGCP, and the motivation to combine the references is deficient.

Applicant further traverses the scope of the teaching relating to MGCP. Claims 2, 10, 37, 53, and 56 recite that receiving a request includes receiving a request from an MGCP call agent. The request is a request to play the sequence of audio segments (claim 1). At col. 6, lines 33-42 of Schuster, the scope of the MGCP functionality is described and makes it clear the MGCP protocol may be used to configure the HSLIC cards, but makes no indication that a request for playing audio segments is sent from an MGCP call agent. It is not true to say that configuring an HSLIC card is the same thing as a request to play audio segments. To this extent, the reference does not teach the claim element for which it is cited, and the Patent Office has not established *prima facie* obviousness.

With respect to claims 3 and 11, the Patent Office cites col. 5, lines 52-63. Applicant has studied this passage and notes that this passage talks about a SIP session, not an MGCP session. Schuster discusses MGCP sessions at col. 6, lines 33-42, but even in that passage there is no indication that the request to play a sequence of audio segments includes receiving an MGCP NotifyRequest command from the call agent. To this extent, the reference does not teach the

claim element for which it is cited, and the Patent Office has not established *prima facie* obviousness.

Claim 61 is patentable at least for the same reasons that the underlying claim 60 is patentable.

In light of the deficiencies of the underlying combination and the deficiencies in the analysis of Schuster, Applicant requests withdrawal of the § 103 rejection of claims 2, 3, 10, 11, 37, 53, 56, and 61 at this time.

Claims 8, 9, 41, 42, 57, and 58 were rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Cremia and further in view of Mankovitz. Applicant respectfully traverses. The standard for obviousness is set forth above.

This rejection relies on the underlying combination of Johnson and Cremia. As explained above, this combination is improper for multiple reasons and remains improper in this rejection. Nothing in Mankovitz cures the problems of the combination of Johnson and Cremia. To this extent, the claims are allowable over the rejection of record.

Applicant initially traverses the motivation to combine the references. The Patent Office opines, in its analysis of claim 8, that it would have been obvious to combine Johnson, Cremia and Mankovitz "to provide different level of quality audio data according to user's request [sic]." As noted above, the Patent Office is obligated to provide objective evidence to support a motivation to combine. The Patent Office has not done so in this case, and the combination is thus improper. Even if there was objective evidence of this motivation, the motivation does not compel the combination. Nothing in Mankovitz appears to satisfy a desire to provide different level of quality audio data according to a user's request. If the Patent Office disagrees, the Patent Office is requested to elaborate on what was intended.

Applicant further traverses the rejection of claims 8, 41, and 57 on the grounds that Mankovitz does not teach the claim element for which it is cited. Specifically, the Patent Office opines that Mankovitz discloses the set contains a plurality of levels of audio data qualifiers and the selector specifies a path through the levels that leads to the member corresponding to the audio segment to be played, pointing to col. 8, lines 11-18 and 38-57. Applicant has studied these passages. The first passage talks about FM frequencies available for use for broadcast and modulation levels. FM frequencies available for use for broadcast and modulation levels are not the same thing as the recited levels of audio data qualifiers and a selector that specifies a path

through the levels. The second passage describes a transmitter with a data source 54 and a code generator 58 therein. The code generator 60 provides a pulse code to the amplifier which varies the amplitude of the signal to be transmitted according to a PAM scheme. This is not the same as the recited claim element, nor would anyone of ordinary skill in the art consider either passage to teach or suggest the claim element. If the Patent Office disagrees, Applicant requests that the Patent Office clarify what element within the passage is being construed as the selector and what element is the set with a plurality of levels of audio data qualifiers which the selector specifies a path through that leads to a member corresponding to the audio segment to be played.

Applicant further traverses the rejection of claims 9, 42, and 58 on the grounds that Mankovitz does not teach the claim element for which it is cited. Specifically, the Patent Office indicates that Mankovitz discloses that the set contains a plurality of levels of audio data qualifiers and the selector specifies a partial path through the levels and selecting the audio data segment to be played includes traversing the levels in the order specified by the selector and supplying default paths through levels not specified by the selector, pointing to col. 10, line 56-col. 11, line 10. Applicant has studied this passage and notes that the passage deals with displaying to which station the radio is tuned and storing in memory the radio station presets. This is not the same as the recited claim language, nor would anyone of ordinary skill in the art construe these components to be the same things.

In light of the deficiencies of the underlying combination, and the deficiencies in the reference, Applicant requests withdrawal of the § 103 rejection of claims 8, 9, 41, 42, 57, and 58 at this time.

Claims 14, 15, and 43-45 were rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Cremia and further in view of Szlam. Applicant respectfully traverses. The standard for obviousness is set forth above.

This rejection relies on the underlying combination of Johnson and Cremia. As explained above, this combination is improper for multiple reasons and remains improper in this rejection. Nothing in Szlam cures the problems of the combination of Johnson and Cremia. To this extent, claims 14, 15, and 43-45 are allowable over the rejection of record.

Applicant further traverses the motivation to combine the references. The Patent Office opines, in its analysis of claim 14, that it would have been obvious to combine Johnson, Cremia and Szlam "to provide portability to the system and also allow to support multiple groups of

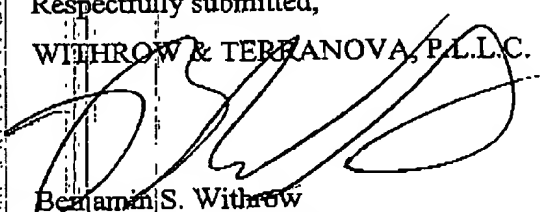
recipients." As noted above, the Patent Office is obligated to provide objective evidence to support a motivation to combine. The Patent Office has not done so in this case, and the combination is thus improper. Applicant requests the withdrawal of the § 103 rejection of claims 14, 15, and 43-45 at this time.

Applicant requests reconsideration of the rejection in light of the arguments presented herein. Specifically, the primary references are not properly combinable and even if they are, they do not teach all the claim elements such that the Patent Office has not established *prima facie* obviousness. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

  
Benjamin S. Withrow  
Registration No. 40,876  
P.O. Box 1287  
Cary, NC 27512  
Telephone: (919) 654-4520

Date: January 22, 2004  
Attorney Docket: 7000-045

CERTIFICATE OF TRANSMISSION	
I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:	
Examiner: <u>Nguyen, Dustin</u>	Art Unit: <u>2154</u> Fax: <u>703-872-9306</u>
<u>Kelly Farrow</u> Name of Sender	
<u>Kee</u> Signature	
<u>1/22/04</u> Date of Transmission	